

### **REMARKS**

The subject application is a continuation of application Serial No. 08/488,691. In the Decision On Appeal mailed on August 12, 2005, the Board sustained the Examiner's rejection of claims 18-25 under 35 U.S.C. § 112, but did not sustain the Examiner's rejections of claims 26-40. In the Office Action of August 27, 2007, the Examiner reopened prosecution and presented new art rejection on the merits.

#### **Claim Rejections under 35 U.S.C § 112**

Claim 18 has been amended to eliminate references to different "transmission media", and to recite "the program including a pointer to the alternate TV program on an alternate TV channel" to address the objections to the lack of antecedent basis for the limitation in claims 24 and 25.

#### **Claim Rejections under 35 U.S.C § 102**

Claims 18-19, 21, and 23-25 are rejected under 35 U.S.C § 102(b) as being anticipated by Wachob (U.S. Pat. No. 5,155,591). Wachob describes a system for providing "different commercial messages ... to different demographically targeted audiences" (Abstract). However, while the messages are determined by the demographics of a specific user, the messages are not necessarily directly related to the subject material of the program itself, as specified in amended independent claim 18.

Claims 26, 30-34, and 37-40 are rejected under 35 U.S.C § 102(e) as being anticipated by Hite (U.S. Pat. No. 5,774,170). Like Wachob, Hite provides for "Targeted Marketing" --- to "provide advertisers with less waste and greater cost effectiveness in delivering their messages only to those consumers who are desirable prospects." (3:24-28). Thus, again, these messages are determined by the demographics of the user, and not necessarily directly related to the subject material of the program itself.

Claims 26, 30-34, and 37-40 are rejected under 35 U.S.C § 102(e) as being anticipated by Nemirofsky (94/03995). Like Wachob and Hite, Nemirofsky also is directed to targeted marketing, such that "the series of programs played in one receiving site could be quite different from that played in another" (Abstract) and "Unique programs tailored to a particular demographic market are assembled on-line and broadcast simultaneously to a multitude of different locations." (2:26-

28) However, these assembled programs are targeted to specific markets, not to specific users. In addition, the switching of source material is conducted at the time the local version of the program is created, and thus is specific to the receiving terminal, as determined from the point of transmission.

**Claim Rejections under 35 U.S.C § 103**

Claim 20 is rejected under 35 U.S.C § 103(a) as being unpatentable over Wachob. Claim 20 is dependent from claim 18, which has been amended. Applicant believes that this claim is now distinguished from Wachob, which does not teach that the messages are directly related to the subject material of the program itself.

Claim 22 is rejected under 35 U.S.C § 103(a) as being unpatentable over Wachob, in view of Cherrick (U.S. Pat. No. 5,528,304). Cherrick provides a disclosure of selecting a program, using a remote control and with an "on-screen programming guide". Applicant believes that this claim (which is dependent from amended claim 18), is now distinguished from Wachob, which does not teach that the messages are directly related to the subject material of the program itself.

Claims 27-29 and 33-36 are rejected under 35 U.S.C § 103(a) as being unpatentable over Hite, in view of Cherrick. Applicant believes that claims 27-29 and 33 (which depend from amended claim 26) and claims 34-36 (which set include amended independent claim 34 and its dependent claims 34-36), are now distinguished from Hite, which does not teach that the messages are directly related to the subject material of the program itself.

Based upon the foregoing amendments and comments, Applicant believes all pending claims are in condition for allowance. Questions regarding this application may be directed to the undersigned attorney at the telephone and facsimile numbers provided.

Respectfully submitted,

By: 

John G. Posa (Reg. No. 37,424)  
Gifford, Krass, Sprinkle  
PO Box 7021  
Troy, MI 48007  
(734) 913-9300 FAX (734) 913-6007

Date: Feb. 27, 2008